

It is submitted that the finality of the Office Action is premature, because the new rejection was not necessitated by the claim amendment. Therefore, the withdrawal of the finality of the rejection is respectfully requested.

Further, the rejection of claims 1-11 under 35 U.S.C. 102 is respectfully traversed for the following reasons.

Claim 1 recites a memory system for a portable telephone including a signal transmission/reception portion for transmitting and receiving a signal and a control portion for controlling at least a signal transmission and reception operation of the transmission/reception portion. The memory system comprises:

- a random access memory (RAM) providing a working area for said control portion; and
- a file storage flash memory for storing a program for said control portion and at least transmission and reception data in a non-volatile manner under a control of said control portion.

Independent claims 10 and 11 also recite a random access memory providing a working area for the control portion; and a file storage flash memory for storing a program for the control portion and at least transmission and reception data in a non-volatile manner under a control of the control portion.

The Examiner considers the cordless telephone in FIG. 41 of Kuroda to correspond to the claimed portable telephone. The flash memory FLASH in the microcomputer 102 is considered to correspond to the claimed file storage flash memory. The RAM shown in FIG. 1 of the reference is considered to correspond to the claimed RAM.

However, the reference does not teach that the flash memory FLASH is a file storage flash memory for storing a program for the control portion, and transmission and reception data in a non-volatile manner under a control of the control portion.

The Examiner relies upon col. 6, lines 21-23. However, this portion of the reference relates to the embodiment in FIG. 1, which is a microcomputer rather than a telephone device. The reference teaches that "the flash memory FMRY is programmed with desired data and program." However, the embodiment in FIG. 1, which does not include a telephone device, provides no reason to conclude that these "desired data and program" include a program for controlling transmission/reception and transmission and reception data, as the claims require.

Moreover, in col. 5, lines 30 to 33, the reference describes that the flash memory stores the information to be processed by CPU, and the stored information can be erased and programmed. Accordingly, the reference does not suggest storing a program for the control portion that controls at least a signal transmission and reception operation of the transmission/reception portion, as the claims require.

In addition, the reference does not disclose that the flash memory FLASH is a file storage flash memory.

Further, the RAM shown in FIG. 1 of the reference is considered to correspond to the claimed RAM. However, FIG. 1 of Kuroda shows a microcomputer rather than a telephone device. Therefore, the RAM in FIG. 1 cannot provide a working area for controlling at least a signal transmission and reception operation of the transmission/reception portion for a portable telephone, as the claims require.

Instead, Kuroda teaches that the RAM is used as a work area for rewriting data from the small memory block SMB or a data buffer area. The reference contains no teaching that the block SMB controls a signal transmission and reception operation in a telephone device.

Anticipation, under 35 U.S.C. § 102, requires that each element of a claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1920 (Fed. Cir. 1989) *cert. denied*, 110 S.Ct. 154 (1989). The term "anticipation," in the sense of 35 U.S.C. 102, has acquired the accepted definition meaning "the disclosure in the prior art of a thing substantially identical with the claimed invention." *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978).

As demonstrated above, the reference does not expressly disclose:

- a random access memory providing a working area for the control portion that controls at least a signal transmission and reception operation of the transmission/reception portion for a portable telephone; and
- a file storage flash memory for storing a program for this control portion and at least transmission and reception data in a non-volatile manner under a control of the control portion, as the claims 1, 10 and 11 require.

In the event the Examiner relied upon inherency without expressly indicating such reliance, the Examiner should be aware that inherency requires certainty, not speculation.

In re Rijckaert, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721

F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner provided no factual basis upon which to conclude that the flash memory FLASH is **necessarily** a file storage flash memory for storing a program for the control portion, and transmission and reception data in a non-volatile manner under a control of the control portion, and that the RAM shown in FIG. 1 of the reference **necessarily** provides a working area for the control portion.

Moreover, as discussed above, one skilled in the art would recognize that Kuroda provides no reason to conclude that the flash memory FLASH is a file storage flash memory for storing a program for the control portion, and transmission and reception data in a non-volatile manner under a control of the control portion, and that the RAM shown in FIG. 1 of the reference provides a working area for the control portion, as the claims 1, 10 and 11 require.

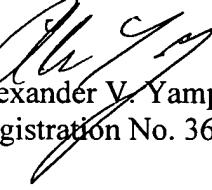
Accordingly, Kuroda et al. does not describe the claimed invention within the meaning of 35 U.S.C. § 102. Applicant, therefore, respectfully submits that the rejection of claims 1-11 under 35 U.S.C. § 102 as anticipated by Kuroda et al. is untenable and should be withdrawn.

In view of the foregoing, and in summary, claims 1-11 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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